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REMARKS

In the Office Action, all of the pending claims, i.e. 1-9 were rejected. Claims 1-9 were rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by the combination of U.S. Patent No. 5,499,917 to Erikson, *et al.* (hereinafter "Erikson") in combination with U.S. Patent No. 6,610,390 to Kauschke, *et al.* (hereinafter "Kauschke"). The Examiner acknowledges that Erikson does not disclose the dimensions of the depressions and relies on Kauschke to teach same. According to the Examiner, it would be obvious to modify Erikson to include depressions sized and spaced as the ranges taught by Kauschke and to include an absorbent material to obtain the desired properties. Additionally, claims 1-9 were rejected under 35 U.S.C. § 112, second paragraph as indefinite for use of the word "especially" and "/" as well as use of a trademark.

Via this Amendment, Claims 1, 3, 4, 6-8 have been amended to omit further limiting clauses beginning with the term "especially". New claims 10-15 have been added to encompass subject matter in the omitted clauses. No new matter is added via this amendment. The tradename Teflon has been replaced by its chemical name, i.e., polytetraflurorethylene (PTFE). The symbol "/" as in "a layer of silicone/SEBS/Teflon" has been deleted and replaced with "a layer of silicone, SEBS and polytetrafluoroethylene." Support for this amendment is found in the specification at page 5, third paragraph.

In view of these amendments, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

Turning to the substantive rejections, Claims 1-9 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Erikson and Kauschke. The Examiner states that Erikson shows an elastic material; made from a thermoplastic with a surface with depressions. The Examiner admits that Erikson does not state the dimensions of the depressions and relies on

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Kauschke to teach same. For claim 3, the Examiner states that Kauschke teaches the use of an absorbant material. For claim 4, the Examiner states that the range of depth of depressions is an obvious matter of choice in the size of a known element to one of ordinary skill in the art. For claim 6, the Examiner states Kauschke teaches the use of different shapes. For claim 8, the Examiner states that both Erikson and Kauschke teach using silicone.

Applicants disagree, respectfully traverse this rejection, and offer the following arguments.

Preliminarily, we note that the Kauschke reference appears to be directed to non-analogous art. That is, the reference is not reasonably pertinent to the particular problem or field of endeavor with which the present inventor is involved.

Erikson discloses a dental isolation dam comprising two polymer films, between which a set of elastic fibers are located, arranged in adjacent pairs and spaced apart a distance generally equal to the average mesial-distal width of a tooth (See claim 1). The fibers are assembled in such a manner that the first set of fibers is arranged in a direction perpendicular to the second set of fibers to provide a crisscrossed, rectangular pattern (See column 3, lines 19 to 22). The first set of fibers is spaced apart between about 6 mm and 10 mm and the second set of fibers is spaced apart between about 7 mm and 11 mm (See column 3, lines 27 to 32), thus providing a "network of meshes". During the process of preparation of the laminate, due to the elasticity of the individual components of the laminate, intermediately a shirred laminate results having a puckered or gathered configuration (See column 3, lines 14 to 17). However, upon stretching the laminate, its surface will become smooth again.

Unlike Erikson, the rubber dam covering means according to the present invention has at least one side provided with a structured surface having a plurality of depressions each having an

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extent of from 0.10 mm to 0.50 mm in the surface plane and a spacing of from 0.05 mm to 0.30 mm. Accordingly, the rubber dam covering means differs from the dental isolation dam according to Erikson in that it comprises a structured surface. Addiitonally, meshes according to the present invention are much smaller than the "network of meshes" according to Erikson.

When using the dental isolation dam of Erikson, holes are punched in the dam and the holes are placed over teeth (See column 4, lines 37 to 45). The elasticity of the dam according to Erikson is not due to the polymer film, but due to the elastomeric fibers located therein between. Accordingly, once such a fiber is hit and cut when punching the holes, the dental isolation dam can no longer be used in order to isolate teeth because the resilience of the fibers no longer exists. Only within the crisscrossed, rectangular patter formed by the fibers, such holes may be punched in order to provide isolation of teeth. However, the rectangular pattern according to Erikson being between about 6 mm and 10 mm in one direction and between about 7 mm and 11 mm in the other direction (See column 3, lines 27 to 32) does not correspond to the anatomy of teeth. Thus, isolation of adjacent teeth is not practicable with the dental isolation dam of this reference.

Unlike Erikson, the rubber dam covering means according to the present invention is made of a thermoplastic material which is elastic at room temperature. Accordingly, no fibers providing elastic properties are required. Thus, holes can be punched regardless of a restricting and fixed pattern of elastic fibers. Furthermore, the material according to the present invention is so elastic that a hole with a diameter of about 1 mm is sufficient to cover a tooth having a diameter of about 20 mm. Moreover, the rubber dam covering means according to the present invention is provided with a structured surface allowing that the surface plane is substantially

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retained as contact surface, so that a relatively high adhesive action is obtained on the side in question (See page 3, penultimate paragraph).

To summarize, the rubber dam covering means according to the present invention differs from the dental isolation dam according to Erikson, in that it is made of a thermoplastic material that is elastic at room temperature without requiring the presence of elastic fibers, and in that it has a structured surface having a plurality of depressions each having an extent of from 0.10 mm to 0.50 mm and a spacing of from 0.05 mm to 0.30 mm. Erikson neither teaches nor suggests the features of the present invention.

Kauschke is directed to a nonwoven with non-symmetrical bonding configuration. Although it is disclosed in column 9, lines 58 to 67, that such a nonwoven can be used, among others, in a variety of medical applications, such as surgical drapes. Surgical drapes are in no way tantamont to rubber dental dams. One skilled in the art faced with the object of the present invention would not have turned to this reference.

Kauschke pertains to a nonwoven wherein the elongation properties are influenced by the arrangement of the bonding points. Especially by the non-symmetrical bonding configuration as proposed in Kauschke, the elongation properties can be adjusted in that a high elongation is obtained in a first direction (particularly the cross direction) and low elongation is obtained in a second direction (typically the machine direction) (See column 2, lines 3 to 15). In fact, the object of Kauschke is to provide a nonwoven having different elongation properties in the respective different directions.

The Kauschke object differs completely from the requirements of the rubber dam covering means according to the present invention. In the present case, equal and regular

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elongation properties are required in both directions because a circular hole is punched in the rubber dam covering means according to the present invention in order to cover a substantially circular tooth. Thus, equal and regular elongation properties in both directions represent a fundamental requirement for the object of the present invention. In fact, Kauschke actually teaches away from the present invention inasmuch as the non-symmetrical elongation properties (See column 2, lines 3 to 15) render the nonwoven according to Kauschke completely unsuitable for use as a rubber dam covering means. Accordingly, a person skilled in the art faced with the object of the present invention would not at all turn to Kauschke as the respective objects of these two inventions are completely the opposite from each other. Further, such teaching away is indicative of non-obviousness.

Furthermore, as it is evident from Figure 8 of Kauschke, the nonwoven would require several layers to be capable of firmly sealing a tooth. Contrary thereto, the rubber dam covering means according to the present invention does not require the presence of further layers in order to firmly seal a tooth.

Further evidence of the teaching away by Kauschke is that if the Kauschke nonwoven would be used as a rubber dam covering means, the bonding points, adjusting the elongation properties of the nonwoven, would probably be hit and destroyed when punching a hole in the nonwoven. Thus, the elongation properties of the nonwoven would be completely altered and would become unpredictable in addition to the initial non-symmetrical elongation properties as previously discussed. Accordingly, the nonwoven disclosed in Kauschke would not at all be suitable for use as a rubber dam covering means.

In making a *prima facie* case for an obviousness rejection under 35 U.S.C. §103, the Office Action must point to specific information in the prior art references that suggest

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combining the references. See In re Dembiczak, 175 F3d 994, 1000, 50 USPQ 2d 1614, 1618 (Fed. Cir. 1999). It is required to explain, when analyzing the prior art, what specific understanding or technical principle would have suggested the combination. Rouffet, 149 F3d at 1357, 47 USPQ 2d at 1450.

Here the Office Action failed to identify the motivation to combine. It did not point to any specific information in the prior art references that suggested combining the references. Instead the teachings in the present invention were used as a guidepost and basis to justify the combination. This is impermissible hindsight.

Thus, the Office Action failed to provide the appropriate basis or motivation that suggests combining the references in the manner that it did, as required in support of a rejection under 35 U.S.C. §103 for a combination of prior art references. Applicants submit that it is not obvious to apply the teachings of the Kauschke reference to obtain the desired properties nor would the application of those teachings lead to the present invention.

Accordingly, the Examiner is respectfully requested to withdraw the rejection.

In view of the remarks set forth above, this application is in condition for examination and ready passage to allowance, which is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for examination or allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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